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REMARKS

Claims 1-8 are pending and under consideration. Claims 1, 7, and 8 have been amended. Claims 9-12 have been cancelled without prejudice or disclaimer. Support for the amendments to the claims may be found in the claims as originally filed, at page 7, lines 8-21, page 14, lines 12-24, page 17, lines 16-27, and page 18, lines 1-16 of the specification, and in Fig. 2. Further reconsideration is requested based on the foregoing amendment and the following remarks.

RESPONSE TO ARGUMENTS AND COMMENTS IN THE ADVISORY ACTION

The Applicant appreciates the consideration given to their arguments. The Applicant, however, is disappointed that their arguments were not found to be persuasive. In the Amendment filed on February 27, the Applicant argued that Bahar (i.e., U.S. Patent No. 6,694,355 to Bahar et al.) does not teach or suggest "determining a final design of the product in which each element is as specified in one of the amended options." The final Office Action considers that the adopted option is the winning design. This assertion, however, appears to contradict the argument¹ that the plurality of questions in the questionnaire and the view of sections as questions and parts as multiple-choice answers because one adopted option would correspond to one question as opposed to a plurality of questions. In the comments provided with the Advisory Action, the Examiner argues that he does not see the contradiction because

Just as a questionnaire can contain one or more questions, a product can consist of one or multiple parts, each part can be rewarded individual in Bahar or the entire product can be rewarded in Bahar. Since Bahar teaches that there is at least one winner, then multiple winners and hence products containing multiple parts are also taught.

Applicant respectfully disagrees with the above-cited chain of assertions because the Examiner erroneously goes from particular to general, from winner(s) of chosen design(s) of a product to multiple winners for multiple parts composing a design. Even if there are multiple winners in Bahar, each winner is the author of a complete design of the product in Bahar. Bahar does not teach the public providing input for each of multiple parts of the product.

The Applicant also argued that the combination of Bahar and Murphy used to reject claim 2 is based on improper hindsight. The final Office Action cites *In re McLaughlin*, 443 F.2d 1392 (CCPA 1971) to support the position that hindsight is permissible if it takes into account only

¹ See, the Office Action mailed on 05/04/2006, Page 3, a.

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knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made. However, *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998) sets forth criteria for being certain that impermissible hindsight is not being used to deprecate an invention².

In view of the criteria, the Applicant respectfully maintains that claim 2 is not obvious over the combination of Bahar and Murphy, because the final Office Action shows no reason to combine the references. The outstanding Office Action identifies no common problem confronting the skilled artisan for which the artisan would have selected certain elements of Bahar to combine with Murphy. Once a winning design is selected among the designs submitted from remote host computers in Bahar, an artisan would have no reason to "poll" the public to choose a winner. In the Advisory Action, the Examiner asserts that if the Bahar method chose more than one winning design then a polling of the winning design may have followed. However, Bahar makes no suggestion of a second public inquiry and including the polling in the initial gathering of designs from participants is illogical.

Further, the final Office Action asserts that the motivation to combine is provided in Bahar col. 6, lines 59-63 (the whole paragraph is reproduced below, with emphasis added):

In this manner, the method and system 100 of the present invention would allow the manufacturer of a product to get a wealth of design suggestions for their respective product. This will give the manufacturer an exorbitant amount of design ideas, many of which the manufacturing company would never have conceived of independently. It would also expose a manufacturer to the public's varying opinions and input of what the product should look like. **Being informed of the going consumer trends/styles of the times, the manufacturer would be able to design the product so as to maximize its potential sale.** Implementation of this invention may also help promote awareness of a particular product line.

Read in context, the indicated lines from Bahar do not provide a motivation to poll the users. The whole paragraph, rather, encourages practicing the method disclosed in Bahar in order to obtain "an exorbitant amount of design ideas, many of which the manufacturing company would never have conceived of independently." Therefore, it is respectfully submitted that the final Office Action has failed to establish a *prima facie* case of obviousness.

In response to the obviousness rejection of claim 4, the Applicant argued that the combination of Bahar and Crane is not a proper combination because there is no evidence of

² "To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed" (emphasis added). *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998).

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motivation to combine in the references. In the rebuttal of this argument, it is asserted that the method of distributing the awards is "basic financial information".

Bahar's method, however, rewards one winning design and therefore, there is no reason to distribute the award to the one winner using a payment distribution scheme. Bahar provides no motivation for using the payment distribution scheme of Crane. Rewarding the participants to the survey may be performed in a different manner than the claimed payment distribution scheme. For example, each participant may receive a flat fee for answering the questionnaire and not receiving points according to how much the participant choices match the adopted choices. In view of the above discussion, the Applicant respectfully submits that Bahar and Crane do not render claim 4 obvious. Further reconsideration is thus requested. In the comments provided with the Advisory Action, the Examiner challenges the above argument because Bahar leaves open the possibility to have more than one winning design. However, this possibility does not by itself contradict the above argument, because even if there is more than one winning design, there is no suggestion or teaching in Bahar of rewarding differently the winning designs.

CLAIM REJECTIONS - 35 U.S.C. § 102

Claims 1, 3, 6, 7, and 8 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 6,694,355 to Bahar et al. (hereinafter "Bahar"). The rejection is traversed to the extent it would apply to the claims as amended. Reconsideration is earnestly solicited.

In the claimed invention, the recipient of the points is decided for each element independently of any other element. There is thus no absolute winner in the claimed invention, as there is in Bahar. The eighth clause of claim 1, in particular, recites:

Wherein the one adopted option is specified independently of a result of a specification of any other element.

Bahar neither teaches, discloses, nor suggests "the one adopted option is specified independently of a result of a specification of any other element," as recited in claim 1. In Bahar, rather, an award incentive is preferably provided to *winning* designs, as described in the Abstract.

Furthermore, in the claimed invention, the incentive is distributed to all participants who selected at least one adopted option for any element, according to the degree of their contribution to the final design. The ninth clause of claim 1, in particular, recites:

Wherein, for each respective element, all of the participants who have selected

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the adopted option on the questionnaire are specified and respectively given points corresponding to a weight value which is predetermined for the element.

Bahar neither teaches, discloses, nor suggests "for each respective element, all of the participants who have selected the adopted option on the questionnaire are specified and respectively given points corresponding to a weight value which is predetermined for the element," as recited in claim 1. In Bahar, rather, at least one *winner* is selected to receive a corresponding award incentive. In particular, as described at column 6, lines 30-36:

After stably receiving a sufficient plurality of final designs, one preferred embodiment of the method 100 further provides a step of selecting at least one winner to receive a corresponding award incentive (not shown). The selection is preferably made based on pre-defined selection criteria, such as the degree of variance between the final design and a pre-determined design scheme.

Since, in Bahar, at least one winner is selected to receive a corresponding award incentive, Bahar does not show "for each respective element, all of the participants who have selected the adopted option on the questionnaire are specified and respectively given points corresponding to a weight value which is predetermined for the element," as recited in claim 1.

Furthermore, in the claimed invention, the points given to each participant for all of the elements is used to determine the degree of their contribution to the design. The more the design of each element influences the whole design, the greater the number of points given to those participants selecting the adopted design for that element, in proportion to the predetermined weight value of the element.

Then, the points given to each participant are tallied up, which decides the degree of contribution of each participant among all of the participants. Thus, in the claimed invention, the incentive is distributed to each of the participants who have selected an adopted option for at least one element, in accordance with the degree of the contribution of each participant to the final design. The eleventh clause of claim 1, in particular, recites:

Wherein the incentive to be distributed to each participant is proportional to a sum of the points given to the respective participant relative to a total number of points given to the participants.

Bahar neither teaches, discloses, nor suggests "the incentive to be distributed to each participant is proportional to a sum of the points given to the respective participant relative to a total number of points given to the participants," as recited in claim 1. In Bahar, rather, at least one *winner* is selected to receive a corresponding award incentive, as discussed above.

Since, in Bahar, at least one winner is selected to receive a corresponding award

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incentive, Bahar does not show "the incentive to be distributed to each participant is proportional to a sum of the points given to the respective participant relative to a total number of points given to the participants," as recited in claim 1. Claim 1 is submitted to be allowable. Withdrawal of the rejection of claim 1 is earnestly solicited.

Claims 3 and 6 depend from claim 1 and add further distinguishing elements. Claims 3 and 6 are thus also submitted to be allowable. Withdrawal of the rejection of claims 3 and 6 is also earnestly solicited.

Claim 7:

The eighth clause of claim 7 recites,

Wherein the one adopted option is specified independently of a result of a specification of any other element.

Bahar neither teaches, discloses, nor suggests "the one adopted option is specified independently of a result of a specification of any other element," as discussed above with respect to the rejection of claim 1.

The ninth clause of claim 7 recites,

Wherein, for each respective element, all of the participants who have selected the adopted option on the questionnaire are specified and respectively given points corresponding to a weight value which is predetermined for the element.

Bahar neither teaches, discloses, nor suggests "for each respective element, all of the participants who have selected the adopted option on the questionnaire are specified and respectively given points corresponding to a weight value which is predetermined for the element," as discussed above with respect to the rejection of claim 1.

The eleventh clause of claim 7 recites,

Wherein the incentive to be distributed to each participant is proportional to a sum of the points given to the respective participant relative to a total number of points given to the participants.

Bahar neither teaches, discloses, nor suggests "the incentive to be distributed to each participant is proportional to a sum of the points given to the respective participant relative to a total number of points given to the participants," as discussed above with respect to the rejection of claim 1. Claim 7 is submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 7 is earnestly solicited.

Claim 8:

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The seventh clause of claim 8 recites,

Wherein the one adopted option is specified independently of a result of a specification of any other element.

Bahar neither teaches, discloses, nor suggests "the one adopted option is specified independently of a result of a specification of any other element," as discussed above with respect to the rejection of claim 1.

The eighth clause of claim 8 recites,

Wherein, for each respective element, all of the participants who have selected the adopted option on the questionnaire are specified and respectively given points corresponding to a weight value which is predetermined for the element.

Bahar neither teaches, discloses, nor suggests "for each respective element, all of the participants who have selected the adopted option on the questionnaire are specified and respectively given points corresponding to a weight value which is predetermined for the element," as discussed above with respect to the rejection of claim 1.

The tenth clause of claim 8 recites,

Wherein the incentive to be distributed to each participant is proportional to a sum of the points given to the respective participant relative to a total number of points given to the participants.

Bahar neither teaches, discloses, nor suggests "the incentive to be distributed to each participant is proportional to a sum of the points given to the respective participant relative to a total number of points given to the participants," as discussed above with respect to the rejection of claim 1. Claim 8 is submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 8 is earnestly solicited.

CLAIM REJECTIONS UNDER 35 U.S.C. § 103

Claim 2 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Bahar in view of "MM, MM ... Blue! Public obviously was ready for a change in M&M colors" of Marli Murphy in Kansas City Star, Dayton Daily News, Dayton Ohio, Aug. 19, 1995, page 3C (hereinafter "Murphy"). The rejection is traversed to the extent it would apply to the claims as amended. Reconsideration is earnestly solicited.

Claim 2 depends from claim 1 and adds further distinguishing elements. Bahar neither teaches, discloses, nor suggests "the one adopted option is specified independently of a result of a specification of any other element," "for each respective element, all of the participants who

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have selected the adopted option on the questionnaire are specified and respectively given points corresponding to a weight value which is predetermined for the element," or "the incentive to be distributed to each participant is proportional to a sum of the points given to the respective participant relative to a total number of points given to the participants," as discussed above with respect to the rejection of claim 1. Murphy does not either, and thus cannot make up for the deficiencies of Bahar with respect to claim 2. Claim 2 is thus also submitted to be allowable. Withdrawal of the rejection of claim 2 is also earnestly solicited.

Claim 4:

Claim 4 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Bahar in view of "The Sophisticated Investor" by Burton Crane (hereinafter "Crane"). The rejection is traversed to the extent it would apply to the claims as amended. Reconsideration is earnestly solicited.

Claim 4 depends from claim 1 and adds further distinguishing elements. Bahar neither teaches, discloses, nor suggests "the one adopted option is specified independently of a result of a specification of any other element," "for each respective element, all of the participants who have selected the adopted option on the questionnaire are specified and respectively given points corresponding to a weight value which is predetermined for the element," or "the incentive to be distributed to each participant is proportional to a sum of the points given to the respective participant relative to a total number of points given to the participants," as discussed above with respect to the rejection of claim 1. Crane does not either, and thus cannot make up for the deficiencies of Bahar with respect to claim 4. Claim 4 is thus also submitted to be allowable. Withdrawal of the rejection of claim 4 is also earnestly solicited.

Claim 5:

Claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Bahar in view of "The Sophisticated Investor" by Burton Crane (hereinafter "Crane"). The rejection is traversed to the extent it would apply to the claims as amended. Reconsideration is earnestly solicited.

Claim 5 depends from claim 1 and adds further distinguishing elements. Bahar neither teaches, discloses, nor suggests "the one adopted option is specified independently of a result of a specification of any other element," "for each respective element, all of the participants who have selected the adopted option on the questionnaire are specified and respectively given points corresponding to a weight value which is predetermined for the element," or "the incentive to be distributed to each participant is proportional to a sum of the points given to the respective participant relative to a total number of points given to the participants," as discussed above with

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respect to the rejection of claim 1. Crane does not either, and thus cannot make up for the deficiencies of Bahar with respect to claim 5. Claim 5 is thus also submitted to be allowable. Withdrawal of the rejection of claim 5 is also earnestly solicited.

CONCLUSION

Accordingly, in view of the reasons given above, it is submitted that all of claims 1-8 are allowable over the cited references. Allowance of all claims 1-8 and of this entire application is therefore respectfully requested.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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